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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,856	02/01/2001	Thomas William Rademacher	1012E-909701US	8419

7590

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Emily M. Haliday
Skjerven Morrill MacPherson LLP
Suite 700
25 Metro Drive
San Jose, CA 95110

EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,856

Applicant(s)

RADEMACHER ET AL.

Examiner

Cybille Delacroix-Muirheid

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/254,797.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

The following is responsive to Applicant's election received Dec. 2, 2002.

Applicant's election of Group I, claims 1, 2, 4-12 and 14-20 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Priority

Applicant's claim for priority to foreign application UK 9618930.3 filed Sep. 11, 1996 is noted. However, A claim can only have one effective filing date. Please see Studiengesellschaft Kahle m.b.H. v. Shell Oil Co., 42 USPQ2d 1674, 1677 (Fed. Cir. 1997). In the instant application the claims drawn to the monoclonal antibody, compositions and uses thereof have support back to PCT/GB97/02444 filed Sep. 11, 1997, yet there is no support for the claimed monoclonal antibody in the foreign application. Since the claim as whole can only have one effective filing date, the claims of the instant application will be treated as having an effective filing date of Sep. 11, 1997. An intervening art applied in a rejection may be overcome by cancelling the relevant claim limitations or where appropriate, by submitting an affidavit or declaration under 37 CFR 1.131 to antedate the intervening art.

Information Disclosure Statement

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Applicant's Information Disclosure Statements filed Sep. 5, 2002 have been considered.
Please refer to Applicant's copy of the 1449 submitted herewith.

Claim Objections

1. Claim 11 is objected to because of the following informalities: claim 11 contains language which refers to Tables 3, 4, 5 in the specification. However, this is improper claim format. Should Applicant wish to refer to the variables set forth in the tables, Applicant should submit them as Figures and amend the claim to refer to those figures. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. Claims 1, 2, 4-12, 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1 and 11 recite the limitation "the biological activity" in line 3. There is insufficient antecedent basis for this limitation in the claim. Applicant is respectfully requested to amend said claims by deleting "the" and adding --a--.

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Allowable Subject Matter

Claims 1, 2, 4-12, 14-20 are free from the prior art because the prior art does not disclose or fairly suggest Applicant's claimed monoclonal antibody, pharmaceutical compositions thereof and immunoassay methods employing said antibody.

Conclusion

Claims 1, 2, 4-12, 14-20 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

CDM

April 1, 2003


Cybille Delacroix-Muirheid
Patent Examiner Group 1600